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Modified PTO/SB/21 (08-00)  
Approved for use through 10/31/2002. OMB 0651-0031

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(to be used for all correspondence after initial filing)

		<b>Application Number</b>	09/400,034
		<b>Filing Date</b>	September 21, 1999
		<b>First Named Inventor</b>	Ralph K. ITO
		<b>Group Art Unit</b>	1723
		<b>Examiner Name</b>	Matthew O. Savage
Total Number of Pages in This Submission		<b>Attorney Docket Number</b>	Olympus-13

### ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Response to Missing Parts/ Incomplete Application  <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application)  <input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Postcard Receipt  <input type="checkbox"/> Other Enclosure(s) (please identify below):
	Remarks	

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	John C. Pokotylo (Reg. No. 36,242)
Signature	
Date	April 27, 2004

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Modified PTO/SB/17 (01-03)

Approved for use through 04/30/2003. OMB 0651-0032  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

# FEE TRANSMITTAL for FY 2004

Effective 01/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 0.00)

Complete if Known

Application Number	09/400,034
Filing Date	September 21, 1999
First Named Inventor	Ralph K. ITO
Examiner Name	Matthew O. Savage
Art Unit	1723
Attorney Docket No.	Olympus-13

## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money Order  Other  None

Deposit Account:

Deposit Account Number	50-1049
Deposit Account Name	Straub & Pokotylo

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## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1)</b>		<b>(\$ 0.00)</b>	

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	<input type="text"/> X <input type="text"/> = <input type="text"/>	
Independent Claims	-3** =	<input type="text"/> X <input type="text"/> = <input type="text"/>	
Multiple Dependent		<input type="text"/> = <input type="text"/>	

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	**Reissue independent claims over original patent
1205 18	2205 9	**Reissue claims in excess of 20 and over original patent
<b>SUBTOTAL (2)</b>		<b>(\$ 0.00)</b>

\*\* or number previously paid, if greater. For Reissues, see above

## 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(c)	
1806 180	1806 180	Submission of Information Disclosure	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify)			
* Reduced by Basic Filing Fee Paid		<b>SUBTOTAL (3)</b>	<b>(\$ 0.00)</b>

(Complete if applicable)

Name (Print/Type)	John C. Pokotylo	Registration No. (Attorney/Agent)	36,242	Telephone	(732) 542-9070
Signature			Date	April 27, 2004	

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AF/1723 JFW



IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

Attorney Docket No.: **Olympus-13**

Applicant: **Ralph K. ITO**

Serial No.: **09/400,034**

Filing Date: **September 21, 1999**

Title: **METHODS AND APPARATUS FOR PREPARING A FLUID SAMPLE ALIQUOT**

Examiner: **Matthew O. Savage**

Group Art Unit: **1723**

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P.O. Box 1450  
Alexandria, VA 22313-1450

S I R:

**REPLY BRIEF**

Further to the Examiner's Answer (Paper No. 022004) mailed on February 27, 2004, which set a period of response to expire on April 27, 2004, the applicant requests that the Board further consider this Reply Brief.

**Argument**

The arguments made by the applicant in the Appeal Brief are maintained and incorporated herein by reference. This Reply Brief is intended to supplement, not replace, the Appeal Brief.

**Claim 1 of Group I**

Independent claim 1 is not anticipated by the Ruediger patent because the Ruediger patent does not teach **a constricted passage**, arranged between a channel and a support, **for collapsing a pipette tip of a first part as the first part is inserted into the second part.** Recall that the Ruediger patent describes a valve block C used to dispense, or not dispense, fluid from reactor vessels 10, via outlet tubes 52, into wells 12 of a collection block D. (See, e.g., Figure 1 and column 8, lines 43-51.) Luer tip adapters 56 are used to fluidly couple the reactor vessels 10 with outlet tubes 54. (See, e.g., column 9, lines 48-55 and Figure 4.) More specifically, as shown in Figures 4, 6 and 8, as a slide 44 is moved by a threaded screw 74, each of its spaced, downwardly extending, ribs 66 force a resilient member 68 into an outlet tube 54 arranged between it and a corresponding upward extending rib 62 of a bottom plate 40. This structure operates to form a "pinch valve". (See, e.g., column 9, line 39 through column 10, line 55.) As can be appreciated from this disclosure, as well as reference to Figures 6 and 8, the outlet tube 54 is pinched **after** it has already been situated. (See, e.g., column 10, lines 6-10.) It is not collapsed **as** it is inserted.

In the Examiner's Answer, the Examiner makes two counterarguments. First, the Examiner contends:

the functional limitation "for collapsing a pipette tip of a first part as the first part is inserted into the second part" of claim 1 is broad enough to include the procedure of collapsing the pipette tip **after** situating the pipette tip into a

restricted passage having an adjustable cross section as disclosed by Ruediger et al since the word "as the first part ins inserted into the second part" can be broadly interpreted as meaning "while the first part is inserted into the second part." [Emphases added.]

(Paper No. 022004, page 6.) By proposing the application of such a broad interpretation, the Examiner is, in effect, asking the Board to ignore an important recitation in the claim. That is, under the interpretation proposed by the Examiner, the recitation

constricted passage, arranged between a channel and a support, for collapsing a pipette tip of a first part as the first part is inserted into the second part

would, in effect, simply be interpreted as:

constricted passage, arranged between a channel and a support, for collapsing a pipette tip of a first part.

The applicant respectfully submits that the claimed feature should be given its ordinary meaning, as understood by those skilled in the art, consistent with the objectives and purposes of the invention (See, e.g., the title, "**METHODS AND APPARATUS FOR PREPARING A FLUID SAMPLE ALIQUOT**". Emphasis added.), rather than applying a proposed interpretation that would, in effect, remove claim language from consideration.

Second, the Examiner argues in the alternative:

that the sequence of events implied by the by the phrase "as the first part is inserted into the second part" carries no patentable weight because it relates to the intended use of an apparatus having the same structure to the extent recited in instant claim 1.

(Paper No. 022004, pages 6 and 7.) The applicants note that the language defines a structural relationship between the constricted passage of the second part and the pipette tip of the first part, and is therefore not merely reciting an intended use. Further, the case law makes clear that there is nothing wrong with defining something by what is does rather than by what it is. See, e.g., In re. Swinehart, 169 U.S.Q.P. 226, 228 (CCPA 1971). Finally, as set forth in detail in the Appeal Brief, the claimed structure is not the same as that in the Ruediger patent.

In view of the foregoing, the applicant respectfully submits that the Board should reject the Examiner's proposals to ignore an important claim recitation.

#### **Group IV: Claim 53**

Claim 53 is not anticipated by the Ruediger patent because the Ruediger patent does not disclose a pipette tip that is tapered. In the Examiner's Answer, the Examiner clarified that his position is that element 54 is the pipette tip, and stated:

the pipette 54 is tapered since it includes a tapered portion between an upper larger diameter part receiving a lower end of part 56 and a lower smaller diameter part that is received within the constricted passage.

[Emphasis added.]

(Paper No. 022004, page 9.) Apparently, the Examiner is referring to the cross section of FIG. 8 of the Ruediger patent. As the quoted language of the Examiner's argument shows, the Examiner is ignoring the term "tip" in the phrase "pipette tip". The ordinary meaning of tip is the end of an object, especially a pointed or projecting object. A portion of element 54 in the Ruediger patent that is "between" an upper part and a lower part is clearly not a tip.

**Conclusion**

In view of the earlier filed Appeal Brief, in addition to the foregoing argument which supplements that Appeal Brief, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Board reverse each of the outstanding grounds of rejection.

Respectfully submitted,

April 27, 2004

  
John C. Pokotylo, Attorney  
Reg. No. 36,242  
Customer No. 26479  
(732) 542-9070

STRAUB & POKOTYLO  
620 Tinton Avenue  
Bldg. B, 2<sup>nd</sup> Floor  
Tinton Falls, NJ 07724-3260



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John C. Pokotylo  
John C. Pokotylo

36,242  
Reg. No.